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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/596,582

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Shaun Puckrin

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7590

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Saul Ewing LLP (Philadelphia)

Attn: Patent Docket Clerk

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EXAMINER

CHOY, PAN G

ART UNIT

PAPER NUMBER

3624

MAIL DATE

DELIVERY MODE

03/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,582	Applicant(s) PUCKRIN, SHAUN	
	Examiner PAN CHOY	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6 November 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. The following is a non-final office action in response to Applicant's submission filed on June 16, 2006. Currently claims 1-23 are pending. Claim 1 is the independent claim(s).

Information Disclosure Statement

2. The examiner has reviewed the patents and articles supplied in the Information Disclosure Statements (IDS) provided on November 6, 2007.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No.: PCT/GB04/05281, filed on December 16, 2004; and GB 0329283.6, filed on December 17, 2003.

Claim Objections

4. **Claims 21-22** are objected to under 37 CFR 1.75(c), as being of improper dependent form. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Art Unit: 3624

Regarding Claims 21 and 22, “A computing device” to perform the steps “as claimed in claim 1” is improper because claiming for a computing device is independently from a method claim, and all steps to be performed must be recited within the claim.

5. **Claim 23** is objected to under 37 CFR 1.75(c), as being of improper dependent form. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Regarding Claim 23, “Computer software arranged to cause a computing device as claimed in claim 21” and perform the steps “as claimed in claim 1” is improper because claiming for computer software in claim 23 is independently from a computing device in claim 21, unless the depended claim comprising the computer software in a memory storage, therefore, claim 23 is improper dependent of claim 21, and all steps must be recited within the claim.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Software, programming, instructions or code not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because

they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Regarding Claim 23, claim 23 recites computer software is directed only toward software per se, which is non-statutory subject matter. Accordingly, Claim 23 is not eligible for patent protection.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 12-18, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzpatrick et al., (Fitzpatrick), (U.S. Pub. No.: 2003/0036914).

Regarding Claim 1, Rouse teaches a method of operating a computing device which enables the communication of information between the device and a further computing device, each having a communications capability (see Fig. 1, items 110 and 130; and ¶ 7: *a first portable computing device (PCD) corresponding to a first user a local communication from a second portable computing device corresponding to a second user, the communication can be a wireless communication, an infrared wireless*), the method comprising causing the device to request information regarding contact entries in a contact store accessible by the further device, comparing contact entries of a first contact store accessible by the device with contact entries made available to the device from the contact store accessible by the further device (see Abstract: *a data store including contact information corresponding to the first user and the second user can be accessed*; and ¶ 10: *can be compared to contact information within the first PCD to determine whether one or more common contacts exist*), and notifying at least one of the devices of contacts determined to be common to the first and further contact stores (see ¶ 8: *the second PCD can provide notification to the second user that another user has at least one common contact, and the first PCD can provide notification to the first user that another user has at least one common contract*).

Regarding Claim 2, Rouse teaches a method according to claim 1 wherein the contact store of the device and/or the contact store of the further device is/are arranged as a plurality of overlapping or exclusive groups of contact entries (see ¶ 38: *a person's contact list can be marked private or non-public*).

Regarding Claim 3, a method according to claim 1 wherein contact entries in the contact store of the device and/or the contact store of the further device are selectively excluded from the comparison of contact entries (see ¶ 38: *a contact marked as private or non-public would not be compared to another's contact list in determination of common contacts*).

Regarding Claim 4, a method according to claim 3 wherein at least one of the groups is selectively excluded from the comparison of contact entries (see ¶ 38: *a contact marked as private or non-public would not be compared to another's contact list in determination of common contacts*).

Regarding Claim 5, a method according to claim 1 wherein the contact entries are selected to comprise telephone numbers (see ¶ 29: *the contact clearing house can compare additional features such as telephone numbers*).

Regarding Claim 12, a method according to claim 1 wherein the comparison of contact entries is undertaken by one of the computing devices using data communicated to it by the other (see ¶ 35: *each PCD can include a computer program*

for sending and receiving another person's contact information as well as for comparing that information to locally stored contact information).

Regarding Claim 13, A method according to claim 1 wherein the comparison of contact entries is undertaken by a network server (see ¶ 20: *the contact clearing house can be implemented as one or more computer programs existing within a computer system (server); and ¶ 29: the contact clearing house can receive the message and search the contact lists corresponding to each person identified in the message for common contacts, and the corresponding contact list can be compared. The contact clearing house can compare additional features such as the contact category, i.e., business or personal, address, e-mail address, telephone numbers, and the like*).

Regarding Claim 14, A method according to claim 1 wherein the contacts store accessible by the device and the contacts store accessible by the further device are held respectively on the device and the further device (see ¶ 21: *The contact clearing house can include contact information corresponding to participating users, the contact information can be stored electronically in the form of contact list uploaded from the Portable Computing Devices*).

Regarding Claim 15, A method according to any one of claims 1 wherein the contacts store accessible by the device and the contacts store accessible by the further device are held by a third party (see ¶ 21: *The contact clearing house can be operated by a trusted third party to ensure data integrity and accuracy*).

Regarding Claim 16, A method according to claim 15 wherein the third party comprises the network server (see ¶ 20: *the contact clearing house can be implemented as one or more computer programs existing within a computer system*).

Regarding Claim 17, A method according to claim 1 wherein communication between the device and further device occurs over a wireless link (see ¶ 7: *communication can be a wireless communication*).

Regarding Claim 18, A method according to claim 17 wherein the wireless link comprises any one or more of a cellular phone network, infrared, Bluetooth or a 802.11 WiFi network (see ¶ 7: *a infrared wireless communication, satellite or cellular*; ¶ 20: *a non-local wireless communications link such as cellular or a satellite communication link*).

Regarding Claim 21, A computing device arranged to operate in accordance with a method as claimed in claim 1 (see ¶ 40: *a general purpose computer system with a computer program that when being loaded and executed, controls the computer system such that it carries out the methods described herein*) .

Regarding Claim 22, A computing device according to claim 21 comprising a mobile phone (see ¶ 22: *Portable Computing Devices can be PDA, or cell Phones*).

Regarding Claim 23, Computer software arranged to cause a computing device as claimed in claim 21 to operate in accordance with a method as claimed in claim 1

(see ¶ 40: *a typical combination of hardware and software can be a general purpose computer system with a computer program that when being loaded and executed, controls the computer system such that it carries out the methods described herein*).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above and further in view of Wood et al., (Wood), (U.S. Pat. No.: 44390981 A).

Regarding Claim 6, Fitzpatrick does not specifically disclose wherein selected characters are removed from the telephone numbers; however, Wood discloses “a phone number may be typed with interspersed non-digit characters, these characters are removed from the number, and do not appear when the phone number is displayed” (see col. 14, lines 63-66). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Wood in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the

same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 7, Fitzpatrick does not specifically disclose wherein the telephone numbers are arranged to comprise a country or area code; however, Wood discloses a local phone number (408) 736-7320 including area code (408) (see col. 14, line 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Wood in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above and further in view of Kuhl et al., (Kuhl), (U.S. Pub. No.: 2007/0165861 A1).

Regarding Claim 8, Fitzpatrick does not specifically disclose wherein the contact entries comprise digests of part or all of contacts in the contact stores accessible by the device and the further device; however, Kuhl discloses “to provide at least part of the information accessible by all kinds of devices” (see ¶ 36). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Kuhl in the system of Fitzpatrick, since the claimed invention is

merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above and further in view of Kuhl as applied to claim 8, and Bodnar et al., (Bodnar), (U.S. Pub. No.: 2004/0218045 A1).

Regarding Claim 9, Fitzpatrick does not specifically disclose a method according to claim 8 wherein the digests include a hash key known to the device and the further device; however, Bodnar discloses “the secret hash key known to both the camera device and itself” (see ¶ 122). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Bodnar in view of Kuhl in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 10, Fitzpatrick does not specifically disclose wherein one of the computing devices is arranged to generate the hash key and communicate it to the other device; however, Bodnar discloses “the cellular phone computes the secret hash key known to both the camera device and itself” (see ¶ 122). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the

features as taught by Bodnar in view of Kuhl in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 11, Fitzpatrick does not specifically disclose wherein a network server is arranged to generate the hash key and communicate it to the devices; however, Bodnar discloses “The account management module in the image repository server generates an alpha-numeric user-password such as a secret hash key” (see ¶ 112). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Bodnar in view of Kuhl in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick as applied to claim 1 above and further in view of Bodnar et al., (Bodnar), (U.S. Pub. No.: 2004/0218045 A1).

Regarding Claim 19, Fitzpatrick does not specifically disclose wherein communication between the device and the further device occurs over a wired link;

however, Bodnar discloses “one LAN can be connected to other LAN over any distance via telephone lines” (see ¶ 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Bodnar in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Regarding Claim 20, Fitzpatrick does not specifically disclose wherein the wired link comprises any one or more of Ethernet, Cable, Telephone, and Serial; however, Bodnar discloses “Ethernet network”, “Serial Cable-linked” (see ¶ 73); and “Public Switch Telephone Network” (see ¶ 103). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the features as taught by Bodnar in the system of Fitzpatrick, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Rouse et al., (U.S. Pub. No.: 2002/0087620 A1) discloses a system and method for communication between mobile devices and enabling user to access information using mobile device over wireless data networks..
- Match-Maker for Mobile Phone, FTXT.com, M2 Presswire, Coventry, August 1, 2002; discloses an easy and convenient way of meeting new people by using mobile phones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAN CHOY whose telephone number is (571)270-7038. The examiner can normally be reached on 4/5/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571)272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/PAN G CHOY/

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Examiner, Art Unit 3624

March 11, 2009

/Scott L Jarrett/

Primary Examiner, Art Unit 3624